

REMARKS/ARGUMENTS

Reconsideration of this application is requested. Claims 78-80 are under consideration. Claims 1-77 and 81-127 are withdrawn from consideration.

I. CLAIM AMENDMENTS

Claim 78 has been amended to further clarify that claim. Support for the amendments appears in the paragraph bridging pages 17 and 19 of the specification. No new matter is entered.

II. THE FIRST 35 U.S.C. §112, FIRST PARAGRAPH, REJECTION

Claims 78-80 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. The Examiner has asserted on page 3 of the Action that although *in vitro* models are useful for selecting viruses for further study, they do not necessarily indicate how a virus will behave *in vivo*.

In response, and without conceding to the merit of this rejection, the alleged lack of correlation between *in vitro* and *in vivo* activity is now addressed in claim 78 by reciting that the method is for identifying a virus “likely to have” antineoplastic activity. Withdrawal of this rejection is now respectfully requested.

III. THE 35 U.S.C. §112, SECOND PARAGRAPH, REJECTION

Claims 78-80 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. The Examiner has provided four grounds of rejection as set forth on pages 4-6 of the Action. In response, the proposed amendments to claim 78 are

believed to obviate the rejection. In particular, the term "preferentially" has been removed from claim 78 and replaced by more specific language specifying that the determination that the amount of the virus required to kill the cells deficient in the interferon-mediated antiviral activity is at least 5-fold less than the amount of the virus required to kill the cells competent in the interferon-mediated antiviral activity indicates that the virus is likely to have antineoplastic activity in the mammal. Basis for this language appears in the last paragraph appearing on page 17 of the application as originally filed.

With regard to the fourth ground of rejection appearing towards the bottom of page 5 of the action, the Examiner asserts that one of ordinary skill would not know what type of viral activity is covered by the claims. In response, the method as claimed is not directed to identifying which of several types of viral activity might be responsible for the tumor-cell killing. Rather, the method as claimed identifies viruses with antineoplastic activity regardless of which viral activity is responsible for the neoplastic activity.

Withdrawal of the outstanding 35 U.S.C. §112, second paragraph, rejection is now believed to be in order. Such action is respectfully requested.

IV. THE SECOND 35 U.S.C. §112, FIRST PARAGRAPH, REJECTION

Claims 78-80 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. The method as claimed is described in the paragraph bridging pages 17 and 19 and in the first complete paragraph on page 19 of the specification as originally filed.

A working example is provided in the Example 25. Withdrawal of this rejection is respectfully requested.

V. THE ANTICIPATION REJECTION

Claims 78-80 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Reichard. The Examiner asserts that Reichard inherently teaches applicants' step of using a test virus to infect interferon deficient cells and interferon competent cells. The Examiner asserts that this alleged teaching follows from Reichard's disclosure of using Newcastle disease virus to infect human fibroblasts and several different human tumor cell lines.

Without conceding to the merit of the Examiner's rejection, claim 78 has been amended to specify, in step (a), that a candidate virus is used which has not been previously known to possess antineoplastic activity. It is believed that this amendment overcomes the anticipation rejection over Reichard, since Newcastle Disease Virus described in Reichard was already known to be antineoplastic.

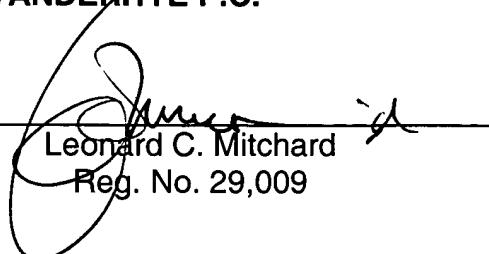
Withdrawal of the outstanding anticipation rejection is now believed to be in order. Such action is respectfully requested.

Favorable action on this application is awaited.

Michael S. Roberts, et al
Appl. No. 10/044,955
May 31, 2005

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Leonard C. Mitchard
Reg. No. 29,009

LCM:lfm
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100